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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,757	06/21/2006	Burkhard Dick	DICK ET AL-2 PCT	8971
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COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER BOOTH, MICHAEL JOHN	
			ART UNIT	PAPER NUMBER
			3774	
			MAIL DATE	DELIVERY MODE
			03/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,757

Applicant(s)

DICK ET AL.

Examiner

MICHAEL J. BOOTH

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 February 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

The examiner reviewed the amendment to the specification and drawings and hereby withdraws the previous objection with respect to the specification and drawings.

The examiner reviewed the amendment with respect to the claims and hereby withdraws the previous objection with respect to the claims.

Applicant's arguments filed 02/26/2009 have been fully considered but they are not persuasive.

The examiner has carefully reviewed the arguments by applicant; however, the claim language as written in its current form does in fact read upon the prior art of record. The applicant begins to argue on pages 11-14 that the reference by Paul does not disclose the invention. On page 14, the applicant points out that Paul fails to disclose a ring consisting alternately of rigid and foldable ring segments. The applicant states that "[these elements are] not stated or suggested at any point in Paul". The examiner respectfully disagrees, in the previous office action on page 3, the examiner stated that Paul discloses a capsular equatorial ring, further with a number of foldable and stiff segments arranged alternately. (Paul does in fact discuss and suggest this in paragraphs 22, 23, and 58 as mentioned previously by the examiner). More specifically, see paragraph 23, where Paul discloses the composite member in the central region ultimately made of a first material, along with a peripheral region made of a second material. Thus, it is believed that Paul discloses the use of alternately

arranged materials. Further, from figure 3, the outer material extends or bulks and has more mass at a location adjacent to that of element (222), then proceeds to connect to another material (namely the center) and then back to the other material located at the peripheral edge.

Continuing on page 14, the applicant continues to argue that Ghazizadeh fails to teach or to suggest the claimed invention and further that a ring for stretching the capsule sac is not described at any point. The examiner combined this reference with that of the reference by Paul to show the dimensions of the ring, since Paul was not focused on the dimensions, the secondary reference, with similar teachings and motivation for combination, does in fact go into more detail about the dimensions. Further, a modification would have involved a mere change in the size of a component, and a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

On page 15, the applicant continues to argue that McNicholas fails to teach the claimed invention. Further the applicant focuses on the ring serves the purpose of stretching the capsule sac and its dimensions. However, the examiner used the reference as a combination to teach the aspect of having a sharp-edged outer periphery along with why one of ordinary skill in the art would do such a thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3, it is not clear if the "peripheral segments" and the foldable creasable and stiff segments are one and the same.

Claim 4, there is no antecedent support for each of "the segment center" and "the inside".

Claim 5, there is no antecedent support for "the segment center".

Claim 6, there is no antecedent support for each of "the segment center" and "the inside".

Claim 8, there is no antecedent support for "the segment center".

Claim 9, it is not clear as to how a "periphery" has a dimension i.e. width. Moreover, the claim as written is confusing since both segments make up the ring and the claim requires the width to be about 0.7mm but the claim also requires the PMMA segment to be 0.5 mm.

Claim 10, it is not clear what structure delineates the "end faces" of the ring.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-7, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul et al. (US Publication 2004/0111151; hereinafter Paul).

Concerning claim 1:

Paul discloses a capsular equatorial ring (210) capable of being implanted in the capsular bag of an eye, and rests against the inside of the capsular bag [0040]. The ring is closed (figure 3) and has a number of foldable [0058] and stiff segments [0022 & 0023] that are arranged alternately [0023] in the peripheral direction. More specifically, see paragraph 23, where Paul discloses the composite member in the central region ultimately made of a first material, along with a peripheral region made of a second material. Thus, it is believed that Paul discloses the use of alternately arranged materials. Further, from figure 3, the outer material extends or bulks and has more mass at a location adjacent to that of element (222), then proceeds to connect to another material (namely the center) and then back to the other material located at the peripheral edge.

Concerning claim 3:

Paul discloses a capsular equatorial ring with peripheral segments designed alternately as stiff PMMA and HEMA/MMA copolymer segments. [0013, 0017, 0022, & 0023].

Concerning claims 4-6:

Paul discloses a capsular equatorial ring where PMMA and HEMA/MMA segments (211) tapers radially and in the axial direction toward the segment center at least from the inside. (See figure 3).

Concerning claim 7:

Paul discloses a capsular equatorial ring having approximately 28% water content. [0042].

Concerning claim 11:

It is inherent that HEMA/MMA copolymer segments are impregnated with a medicament. As defined by the google define feature (define:medicament), a medicament is a substance for curing or healing and is the purpose of the capsular equatorial ring. Also, impregnate is defined as "infusing particles of one substance into the mass of another substance". Since multiple segments make up the ring, it is inherent that these segments are impregnated with a medicament.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul as applied to claims 1 and 3 above, and further in view of Ghazizadeh et al (US Publication 2003/0109925; hereinafter Ghazizadeh).

Concerning claims 2, and 8-9:

Paul fails to disclose a capsular equatorial ring with a PMMA thickness of approximately 0.2 mm, width of the outer ring of approximately 0.7 mm, PMMA being approximately 0.5 mm wide and HEMA/MMA being approximately 0.7 mm wide. However, Ghazizadeh discloses a capsular equatorial ring where the width of the outer ring is approximately 0.7 mm (0.51 mm; [0058, 0060]). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Paul to optimize

the width and thickness of the segments, including number of segments, and ring to allow the device to fit in the capsular bag.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul as applied to claim 1 above, and further in view of McNicholas (US Publication 2004/0039446; hereinafter McNicholas).

Concerning claim 10:

Paul fails to disclose a capsular equatorial ring with a sharp-edged outer periphery. However, McNicholas discloses a capsular equatorial ring with a sharp-edged outer periphery [0011, 0026]. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Paul with McNicholas's sharp-edged to inhibit epithelial cell growth.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. BOOTH whose telephone number is (571)270-7027. The examiner can normally be reached on Monday thru Thursday 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. B./
Examiner, Art Unit 3774
March 4, 2009

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/DAVID ISABELLA/
Supervisory Patent Examiner, Art Unit 3774